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| APPLICATION NO. | FILED DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|------------|------------------------|------------------------|------------------|
| 10/807,953 | 03/24/2004 | Joseph A. Bechtold JR. | 6-002 | 4081 |
| 70? | 7590 | 11/09/2004 | EXAMINER | |
| DAVID A. BURGE CO, L.P.A. 2901 SOUTH PARK BOULEVARD CLEVELAND, OH 44120-1842 | | | EDWARDS, LAURA ESTELLE | |
| | | ART UNIT | PAPER NUMBER | |
| | | 1734 | | |

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|---|---------------------------|---|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/807,953 | BECHTOLD, JOSEPH A. | |
| | Examiner Laura Edwards | Art Unit 1734 | |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i> | | | |
| Period for Reply | | | |
| A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. | | | |
| <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). | | | |
| Status | | | |
| 1) <input type="checkbox"/> Responsive to communication(s) filed on _____. 2a) <input type="checkbox"/> This action is FINAL . 2b) <input checked="" type="checkbox"/> This action is non-final. 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. | | | |
| Disposition of Claims | | | |
| 4) <input checked="" type="checkbox"/> Claim(s) <u>1-48</u> is/are pending in the application. 4a) Of the above claim(s) _____ is/are withdrawn from consideration. 5) <input type="checkbox"/> Claim(s) _____ is/are allowed. 6) <input checked="" type="checkbox"/> Claim(s) <u>1-17,24-29,35,38,40-42,44,46 and 47</u> is/are rejected. 7) <input checked="" type="checkbox"/> Claim(s) <u>18-23,30-34,36,37,39,43,45 and 48</u> is/are objected to. 8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement. | | | |
| Application Papers | | | |
| 9) <input type="checkbox"/> The specification is objected to by the Examiner. 10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) <input type="checkbox"/> The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. | | | |
| Priority under 35 U.S.C. § 119 | | | |
| 12) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. | | | |
| Attachment(s) | | | |
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>062204</u> . | | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____ | |

Claim Objections

Claims 17-23 are objected to because of the following informalities: in claim 17, line 21, “slided” should be changed to --slid--. Also, in line 22, “slided” should be changed to --slid--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1-16, 35, and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 5, “the front face” lacks antecedent basis.

In claim 1, line 12, “the frame” lacks antecedent basis.

In claim 3, line 6, “the frame lip” lacks antecedent basis.

In claim 3, lines 6-7, the perimetricaly extending edge portions” lack antecedent basis.

In claim 13, line 7, “said first and second dimensions” lack antecedent basis.

In claim 35, line 4, “the material” lacks antecedent basis.

In claim 38, line 5, “the material” lacks antecedent basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 5-9, 17, 24-29, 40-42, 44, 46, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panitzsch (US 1,817,928).

Panitzsch teaches a plural element paint shield device for temporarily covering an article being painted comprising plural paint shield elements (16, 17) configured to protectively cover a portion of a front face of an article (see pg. 1, lines 1-7 and lines 70-77) when in an installed position wherein the paint shield elements slidably extend in an adjacent side by side relationship to cover the front face of the article with adjacent ones of the paint shield elements having portions to extend between the frame of the article and perimeter portions of the article with each paint shield element being formed of a thin flat material pliable enough to permit the device to be bent (see pg. 1, lines 98+ to pg. 2, lines 1-4) as well as permit the paint shield elements to be inserted in between the frame of the article and a front face of the article. Panitzsch is silent concerning the device being made of a material that is sufficiently pliable to enable it to flex away from the front face of a lens of a light fixture to permit the lens of the light fixture to be protected upon painting. However, because the Panitzsch paint shield device is made from bendable material, one of ordinary skill in the art would expect the device to be able to be

sufficiently flexible or pliable to enable it to be placed with respect to the lens of a light fixture to protect it from paint.

With respect to claims 5 and 6, even though Panitzsch are silent concerning each of the paint shields being equal in size, it is within the purview of one skilled in the art to provide adjacent or overlapping paint shield elements of an appropriate size and/or dimension in accordance with the size and/or dimension of the area of the article intended to be masked.

With respect to claims 7-9, Panitzsch is silent concerning the type of material (i.e., plastic, cardboard, fiberboard, or chipboard) used to make the paint shield device. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to make the paint shield device from plastic, cardboard, fiberboard, or chipboard since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claim 24, each of the paint shield elements are rectangular in form, flat, and flexible such that the Panitzsch device is capable of being used for masking a rectangular lens of a ceiling mounted light fixture.

With respect to claim 40, even though Panitzsch is silent concerning the device having exact dimensions to match the article being protected, one of ordinary skill in the art would expect the masking device to have dimensions in accordance with the article being masked to provide complete coverage of all exposed surface areas of the article.

Allowable Subject Matter

Claims 18-23, 30-34, 36-37, 39, 43, 45, and 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 4, 10-16, 35, 38 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patent discloses the state of the art with respect to a ceiling display device comprising overlapped elements capable of fitting within ceiling framework wherein the device includes a central see-through window: Martin (US 6,397,531).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Edwards whose telephone number is (571) 272-1227. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Laura Edwards
Primary Examiner
Art Unit 1734

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November 4, 2004